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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/125,114 | 08/18/1998 | IAN ASHLEY PRICE | P8129-8004 | 7439 |

7590 06/14/2002

ARENT, FOX, KINTNER, PLOTKIN & KAHN, P.L.L.C.
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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/14/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------|-----------------|-------------------|
| Advisory Action | Application No. | Applicant(s) |
| | 09/125,114 | PRICE, IAN ASHLEY |
| Examiner | Art Unit | |
| Alysia Berman | 1617 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) The period for reply expires 4 months from the mailing date of the final rejection.

b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. The proposed amendment(s) will not be entered because:

(a) they raise new issues that would require further consideration and/or search (see NOTE below);

(b) they raise the issue of new matter (see Note below);

(c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): the 35 U.S.C. 112, 2nd paragraph rejection.

4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-10, 16-19, 26-31 and 38.

Claim(s) withdrawn from consideration: 11-15, 20-25 and 32-37.

8. The proposed drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. Other: _____.



RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

7. The amendment does not overcome the prior art rejections of record. The Examiner apologizes for any inconvenience caused by the typographical error omitting reference to US 4,844,907 (907) in the heading of item 10 of the final office action. The US '907 patent was referenced in the body of the rejection as is consistent with the rejection of the same claims in the previous office action mailed August 14, 2001, paper no. 22. The claims are directed to a product. Properties exhibited by the product do not provide patentability to the product over the prior art. Additionally, the purpose or intended use of components of the product do not provide patentability over the prior art product containing the same components. The prior art teaches a product containing the same components as instantly claimed. It is reasonable for one of ordinary skill in the art to expect that a product containing the same components would exhibit the same properties. Burden is on Applicant to show that the prior art product does not exhibit the claimed disintegration time and crush strength. The data presented in Figures 1 and 2 of the instant application have been considered but are not found persuasive. The data are not commensurate in scope with the claims. The figures present data comparing products containing sodium carbonate compacted at a certain pressure with products not containing sodium carbonate. The instant independent claims do not require sodium carbonate nor do they recite a compaction pressure. Additionally, the data do not compare the instant invention with the closest prior art, which teaches a product containing the same components as instantly claimed but, as argued by Applicant, not compacted at a sufficient pressure. Burden is shifted to Applicant to show that the compaction pressures of the prior art are not sufficient to obtain the crush strength and disintegration times instantly claimed.

